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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,288	09/11/2003	Michael Zung	6771USP4	5342
57360	7590	08/24/2006	EXAMINER	
WORKMAN NYDEGGER 1000 EAGLE GATE TOWER, 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			ANDERSEN, MICHAEL T	
			ART UNIT	PAPER NUMBER
			3734	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,288

Applicant(s)

ZUNG ET AL.

Examiner

M. Thomas Andersen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement is made of the RCE filed 6/27/2006.

Response to Amendments

All previous rejections have been rescinded. However, new rejections have been made in light of new art and in combination with the art of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1, 3, 5, 8, 11, 12-16** and **19** are rejected under 35 U.S.C. 102(b) as being anticipated by **Yoon**, U.S. Patent No. **5,957,937**. Yoon discloses a suturing device comprising a housing 1080; a shaft 1096 extending distally from a distal end of the housing (when the housing is closed by the shaft or sleeve 1096; See col. 7, lines 25-47); a needle 156 (fig. 7) movable within the shaft and with respect to the housing, the needle being attached to a length of suture (See Abstract); and a suture cutting blade 1186 positioned on the housing such that when the needle is withdrawn from the device, the suture can be drawn across the blade to sever the suture.

Fig. 13 shows that the blade is positioned near the distal end of the housing; and also mounted on the inner surface.

Yoon's device is capable of the state wherein the needle and the suture are withdrawn from the proximal end of the housing.

The needle has a distal end and the suture is attached to the distal end of the needle. See col. 14, lines 41-46.

Yoon also discloses what can be considered a needle actuation handle that is movable through the proximal end of the housing 1080; a needle 156 (fig. 7) extending from the needle actuation handle, through the housing and further through the shaft; and a suture carried by the device, wherein a portion of the suture is positioned near the distal end region of the shaft such that the needle pulls the suture proximally to position the suture through tissue (See figures 7 and 12).

Figure 7 shows that the needle pulls the suture through the proximal end of the housing when suturing through tissue takes place.

The housing 1080 defines an opening near the distal end, and the blade is positioned in the opening (See fig. 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7, 9-10, 17-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon, as applied to claims 1 and 12 above, in view of Ogburn, RE 22,857.

Yoon discloses the invention substantially as claimed except for various locations of the suture-cutting blade. However, *In re Japikse* held that claims that read on the

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prior art except with regard to the position of a claimed element were held unpatentable if shifting the position of the claimed element would not have modified the operation of the device. 181 F.2d 1019; 86 USPQ 70 (CCPA 1950). Simple relocation of the suture-cutting blade does not modify the operation of the claimed device, but merely relocates the location of drawing the suture across the blade.

Furthermore, Ogburn discloses that it is old and well known in the art to use a stationary suture cutting blade on the housing of a medical suturing device for the purpose of severing the suture after it has been applied to the wound (col. 1, lines 29-32; col. 2, lines 11-13; and col. 4, lines 3-10; See also figs. 1-3 and 11-13, reference numerals 51-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a stationary suture cutting blade near the proximal end of the housing, on an outside of the housing, on a finger grip on the housing, or on a movable handle of the device of Yoon, in order to gain the advantage of being able to sever the suture after it has been applied to the wound, as taught by Ogburn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Thomas Andersen whose telephone number is (571) 272-8024. The examiner can normally be reached on M-F 8AM-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Thomas Andersen

August 14, 2006

A handwritten signature in black ink, appearing to read "M J Hayes", written in a cursive style.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER